

## **REMARKS**

### **Claim Rejections**

Claims 1, 3-16, 21, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nichols et al. (US 5,843,099) in view of Yoon '949 (US 5,542,949), Burbank et al. (6,635,065), Blocher et al. (US 6,520,960), and Geiges, Jr. (US 5,830,231). Claims 2, 15, and 17-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nichols et al. in view of Yoon '949, Burbank et al., Blocher et al., and Geiges, Jr., as applied to claim 1, and further in view of Yoon '943 (US 5,704,943).

### **Amendments to Specification**

Applicant has amended the Specification as noted above to cure obvious grammatical and idiomatic inaccuracies. It is believed that the foregoing amendments to the Specification overcome the outstanding objections thereto. No "new matter" has been added to the original disclosure by the foregoing amendments to the Specification.

### **Drawings**

It is noted that the Examiner has accepted the drawings as originally filed with this application.

### **Claim Amendments**

By this Amendment, Applicant has amended claims 1, 8, 12, 15, and 23 of this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

Nichols et al. discloses a tissue clamp. Nichols et al. has a tubular body 12, a fixed handle 18, a moveable handle 22, an operating rod 32, and jaws 58, 64, corresponding to that of the claimed invention. There are many other elements in the invention, which are not disclosed by Nichols et al. The jaws 58 and 64 of

Nichols et al. are moving simultaneously, while the lower jaws 82 of the present invention are fixed, only the upper jaws 84 are movable. Accordingly, they are different from each other. In addition, Nichols et al. are not designed and is unable to operate loop ligatures and cut off the sutures of the loop ligatures.

Nichols et al. do not teach when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly, the pull ring retracting the two first tracking members into the barrel, when the press unit is pressed, the press unit retracting the two second tracking members into the barrel, and when the press unit is located in the pulled position, the press unit retracting the third tracking member and pulling the pull member rearwardly; nor do Nichols et al. when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly, the pull ring retracting the first tracking member into the barrel, and when the press unit is pressed, the press unit retracting the second tracking member first, and then retracting the third tracking member and pulling the pull member rearwardly.

Yoon '949 discloses a clip applier instrument, which is different from the claimed invention. The structure, elements, linkage and operation of Yoon '949 are distinguishable from the present invention. The operations of the jaws 46, 48 and cutter blade 56 are also different from the present invention. Yoon '949 is not designed and is unable to operate loop ligatures and cut off the sutures of the loop ligatures.

Yoon '949 does not teach when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly, the pull ring retracting the two first tracking members into the barrel, when the press unit is pressed, the press unit retracting the two second tracking members into the barrel, and when the press unit is located in the pulled position, the press unit

retracting the third tracking member and pulling the pull member rearwardly; nor does Yoon '949 teach when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly, the pull ring retracting the first tracking member into the barrel, and when the press unit is pressed, the press unit retracting the second tracking member first, and then retracting the third tracking member and pulling the pull member rearwardly.

Burbank et al. discloses a suture ligation device.

Burbank et al. do not teach when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly, the pull ring retracting the two first tracking members into the barrel, when the press unit is pressed, the press unit retracting the two second tracking members into the barrel, and when the press unit is located in the pulled position, the press unit retracting the third tracking member and pulling the pull member rearwardly; nor do Burbank et al. teach when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly, the pull ring retracting the first tracking member into the barrel, and when the press unit is pressed, the press unit retracting the second tracking member first, and then retracting the third tracking member and pulling the pull member rearwardly.

Blocher et al. discloses a bipolar medical instrument. With respect to Blocher et al., all four projections 54 to 60 located on the jaws are for the purpose of concentration of the electric current, which are different from the small blade 95 of the present invention.

Blocher et al. do not teach when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly,

the pull ring retracting the two first tracking members into the barrel, when the press unit is pressed, the press unit retracting the two second tracking members into the barrel, and when the press unit is located in the pulled position, the press unit retracting the third tracking member and pulling the pull member rearwardly; nor do Burbank et al. teach when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly, the pull ring retracting the first tracking member into the barrel, and when the press unit is pressed, the press unit retracting the second tracking member first, and then retracting the third tracking member and pulling the pull member rearwardly.

Geiges, Jr. discloses a surgical instrument having modular elements. Each of the modular elements is different from the present invention. The trigger 23 is distinguishable from the trigger (50) of the present invention. The jaws of the clamp 51 are moving simultaneously. Geiges, Jr. does not operate loop ligatures and cut off the sutures of the loop ligatures.

Geiges, Jr. does not teach when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly, the pull ring retracting the two first tracking members into the barrel, when the press unit is pressed, the press unit retracting the two second tracking members into the barrel, and when the press unit is located in the pulled position, the press unit retracting the third tracking member and pulling the pull member rearwardly; nor does Geiges, Jr. when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly, the pull ring retracting the first tracking member into the barrel, and when the press unit is pressed, the press unit retracting the second tracking member first, and then retracting the third tracking member and pulling the pull member rearwardly.

Yoon '943 discloses a ligating instrument. In Yoon '943, neither the instrument nor the loop ligature is similar to that of claims 1 and 2 of the claimed invention. The ligature supply 14 and the jaws 30 are received in the instrument. The loops 70 are pulling out of the distal end of the instrument for use.

Yoon '943 does not teach when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly, the pull ring retracting the two first tracking members into the barrel, when the press unit is pressed, the press unit retracting the two second tracking members into the barrel, and when the press unit is located in the pulled position, the press unit retracting the third tracking member and pulling the pull member rearwardly; nor does Yoon '943 teach when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly, the pull ring retracting the first tracking member into the barrel, and when the press unit is pressed, the press unit retracting the second tracking member first, and then retracting the third tracking member and pulling the pull member rearwardly.

Even if the teachings of Nichols et al., Yoon '949, Burbank et al., Blocher et al., Geiges, Jr., and Yoon '943 were combined, as suggested by the Examiner, the resultant combination does not suggest: when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly, the pull ring retracting the two first tracking members into the barrel, when the press unit is pressed, the press unit retracting the two second tracking members into the barrel, and when the press unit is located in the pulled position, the press unit retracting the third tracking member and pulling the pull member rearwardly; nor does the combination suggest when the movable handle is located in the closed position, the movable handle moving the upper jaws into the closed position relative to the lower jaws, when the second link is moved forward, the

second link moving the blade toward the front end of the barrel, when the pull ring is moved rearwardly, the pull ring retracting the first tracking member into the barrel, and when the press unit is pressed, the press unit retracting the second tracking member first, and then retracting the third tracking member and pulling the pull member rearwardly.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight

while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Nichols et al., Yoon '949, Burbank et al., Blocher et al., Geiges, Jr., or Yoon '943 that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Nichols et al., Yoon '949, Burbank et al., Blocher et al., Geiges, Jr., nor Yoon '943 disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

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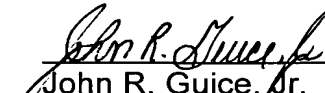
**Summary**

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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